



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Appellant : Ho Keung, Tse.
Application Number : 08/587,448
Filing Date : 12/01/95
Group Art Unit : 2766
Examiner : Laufer, P

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Group 2700

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Hon. Commissioner of Patents and Trademarks, Washington, D.C. 20231,
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Sir,

Reply Brief

This is in response to the Examiner's Answer dated Apr., 07, 99 and is filed by the above-identified appellant.

1) Regarding the Examiner's Answer, P.3, item 6, the Examiner indicates he has made a change in statement of issues but does not make clear what it is. Issue D is not concerned with U.S.C. 101, which is not being found in the final office action, Issue D is concerned with the U.S.C. 102(e) rejection and U.S.C. 112 second paragraph rejection in the final rejection, P.2, items 3, 2b respectively. And, in the Appeal Brief(Substitute), Arguments C & B of Issues C & B respectively and for overcoming the 2 rejections respectively refers to Argument D of Issue D .

Issue D is necessary for providing a basic understanding of the subject matter of the present invention which is not readable directly on the independent claims.

The Examiner incorrectly states that the claimed invention were understood as “a software method” in the final office action, item 2b, and as “software(on a medium)” in the Examiner’s Answer, P.5, rejection 10 b. The latter is consistent with my submission in Arguments B, D.

2) Regarding the Examiner’s Answer, P.5, in his response to Issue A, the Examiner indicates he found difficulties in understanding 2 phrases in claim 1 in Appendix B, the 2 phrases also found in claims 12, 17, the following is respectfully submitted :

Phrase 1 (claim 1, lines 1-4): “Authorising software, stored in a device or physically on a medium, for use on a computer (A) **meeting an existing standard** such that any software product(s) meeting said standard can be used **thereon** and **without modification thereof** ;”

Regarding phrase 1, “**meeting an existing standard**” is immediately after “**computer (A)**” with no comma there between, therefore it is clearly for describing computer (A). The “**there**” in the phrase “without modification **thereof**” refers to the same thing as the “**there**” in the phrase “can be used **thereon**”(line 3), and the same thing being referred to is clearly computer (A).

Phrase 2 (claim 1, lines 5-6): “said authorising software being for, when executed, 1) authorising other software which being protected from unauthorised use, to be used on said computer (A) ;”

Regarding phrase 2, please note that there should be a comma after “for”. The reason(s) why the Examiner cannot parse this phrase is not being provided in the Examiner’s Answer.

To save the time of the Board, I just submit what the Board should know but what is not directly readable thereon. The followings is respectfully submitted :

For the definition of the term “authorising”, it should be readable thereon that it is the “other software” being authorised, not “the user”, and the use of this term is readable in the specification P.3, item 3, and to which should be referred. In the specification, item 3), the ES program which corresponding to the authorising software in the claims, **authorises** program/software to be used by sending encrypted commands thereto(item 3i), or by decrypting encrypted part of software(item 3ii).

Thus, the definition of the term “authorise” in the claims is determinable from the specification and should be equivalent to/replaced by another term “permit”, to avoid confusion. However, the Examiner refused the previous amendments of mine requesting for such a change in the claims. The Examiner is respectfully requested to re-consider entry of those amendment proposals or make the amendment on his own.

This phrase should be interpreted to the extent that once the authorising software authorises the protected software to be used on computer (A), the protected software can be used on computer (A) permanently or temporarily.

For the “permanent” case, a rightful or authorised user although may himself use his authorising software to permanently enable use of the protected software on a computer of an unauthorised user, he will be discouraged from supplying his authorising software together with his identity software, via internet etc., to an unauthorised user at a remote location, for enabling the unauthorised user to use the protected software, because at there the use of the identity software by the unauthorised user can not be monitored by the rightful or authorised user.

For the “temporary” case, the discouraging effect to a rightful or authorised user is more desirable, because it requires the rightful or authorised user to provide greater accessibility of his identity software, or even total ownership of a copy of his identity software, to an unauthorised user, in order that the latter can use the protected software.

To ensure the phrase will not be incorrectly interpreted in a nonsense way, I would like to add “only” after “computer (A)”, and for this the Examiner’s approval is respectfully requested .

3) In the Examiner’s Answer, P.6, in his response to Issue B in Appeal Brief(substitute), the Examiner states that the claims are in narrative form, use primarily intended use and functional language without positive recitations.

The following is respectively submitted :

The rejection of “intended use/outcome language” should be a new ground of rejection not found in the final office action and is not well explained. Such “intended use/outcome language” is commonly found in patents. Again, the Examiner merely indicates at where in the claims he is not satisfied but fails to provide a reason why.

In the Examiner’s argument, the Examiner also fails to indicate why functional language can not be used to define the present invention, which as submitted in argument B of Issue B, being a software but should be understood as a combination of “material”.

At present, I believe that it is not so necessary for me to overcome the new ground of rejection of “intended use language”.

However, I submit herein below in Appendix X, an amendment proposal which positively claims “actual use/outcome” in an attempt to avoid the new rejection.

Regarding phrase 6(lines 21-23), the Examiner states that it is a “description of what is not in system”. Accordingly, it should be deletable and is being deleted in my amendment proposal in Appendix X.

4)

i) In the Examiner's Answer, P.7, in his response to Issue C in Appeal Brief(substitute), the Examiner states that the only characteristic of the "identity software" determinable from the claim language is that it provide identity information. The Examiner argues that the identity of the user computer is a critical component of Ananda's application software to ensure correct monitoring and billing.

The following is respectfully submitted. What I only know is that a) identity of user computer can be determined and verified by the remote centre from the incoming telephone call number, when a telephone contact between the user computer and the remote centre is initiated by the user, b) user enters his identity information including password, into his computer which directly sends it to the remote centre for authentication, and the identity information is not being stored in the user computer. Further, Ananda fails to meet other requirements of my claims, for details, please refer to item 2 herein above and Issue C of Appeal Brief.

The Examiner is respectfully requested to raise a 103 rejection, should he find an appropriate identity software in the prior art which can meet the claims.

ii) Regarding claim 12 which specifies purchase, the Examiner appears to recognise that rental of software is merely a purchase of time limited right of use, whereas software purchases are licensing agreements allowing specific usage rights.

It is respectfully submitted that the specific usage right obtained from software purchased should be time-unlimited but restricted to the purchaser. And, as Ananda's application software is for monitoring the usage time for billing purpose, it is not applicable to protecting purchased software and to rejection of claim 12.

Date : May, 7, 99

Applicant : Ho Keung, Tse.

Signature:

A handwritten signature in black ink, appearing to be 'Ho Keung, Tse', written over a horizontal line.

Appendix X

This is an amendment of claims 1, 12, 17, intended for amending the claims in a better form with the subject matter not being changed and for avoiding the new “intended use/outcome language” rejection.

Please note that the amended claims require “essential information”, this is not new matter and is readable on the specification P.8, last 2 paragraphs- P.9, first paragraph.

I shall file my comments on the allowability of the amended claims, should the Examiner be willing to accept it.

1. (Fourth time amended) [Authorising software, stored in a device or physically on a] [medium, for use on a computer [(A)] meeting an existing standard such that any] [software product(s) meeting said standard can be used thereon and without] [modification thereof ;]

A method for protecting software from unauthorised use, comprising the steps of

:

[said authorising software being for, when executed, 1) authorising other] [software which being protected from unauthorised use, to be used on said computer] [(A); 2)]

determining the [presence] existence of identity software in a memory means under control of a [said] computer [(A)] ;

using a favourable result of said determination of existence as a pre-condition for permitting said protected software to be used on said computer ;

wherein said identity software [being for use on said computer (A) to , with no effective protection against unauthorised use, provide identity] contains information [of] specified to the rightful or authorised user of said authorising software ;

[said identity information being for to be authenticated by a remote computer]
[(B) , in order for] **said information being essentially used, on said computer, in enabling of operation(s) for which said rightful or authorised user has to be responsible** [, to be performed by said remote computer (B)] ; and [the presence of said identity software in said computer (A)] **said determination of existence is being** [determined] **made without causing** a said operation being performed . [by said remote computer (B) ;]

[wherein use of said protected software on said computer (A) will be authorised if said identity software is determined as being present in said computer (A) ; and said authorising software and said identity software being computer software meeting said existing standard ;]

[wherein said computer comprises no hardware specific to said rightful or authorised user for directly or indirectly authorising use of said protected software thereon.]

12.(Fourth time amended) **A method for protecting software from unauthorised use, comprising the steps of :**

creating an “authorising software”;

creating an “identity software”;

combining said identity software and said authorising software together in such a manner that said authorising software is prevented from being copied therefrom individually, to form a “protection software”;

[Protection software , stored in a device or physically on a medium, for use on a computer (A) meeting an existing standard such that any software product(s) meeting said standard can be used thereon and without modification thereof ;]

[said protection software comprising :]

providing no individual protection effectively against unauthorised use, to said identity software in said protection software ;

using said authorising software in said protection software on a computer, for permitting use of said protected software which being purchased for unlimited time of usage, on said computer ;

wherein said identity software in said protection software, [for use on said computer (A) to , with no individual and effective protection , provided by execution of said software, against unauthorised use, provide identity] **contains information specified to** [of] **the rightful or authorised user of [an] said authorising software ;** **said [identity] information being** [for to be authenticated by a remote computer (B) , in order] **essentially used, on said computer, in** [for] **enabling of operation(s) for which said rightful or authorised user has to be responsible.** [to be performed by said remote computer (B) ;]

[authorising software for, when executed, authorising use of other software which being purchased, and being protected from unauthorised use, on said computer (A) ;]

[Wherein said identity software and said authorising software are contained in said protection software in such a manner that said authorising software is prevented from being copied therefrom individually ; and said authorising software and said identity software being software meeting said existing standard ;]

[wherein said computer comprises no hardware specific to said rightful or authorised user for directly or indirectly authorising use of said protected software thereon.]

17.(Fourth time amended)) **A method for protecting software from unauthorised use, comprising the steps of :**

creating an authorising program ;

[Authorising program , stored in a device or physically on a medium and meeting an existing standard, for use on a computer (A) which meets said existing standard such that any software product(s) meeting said standard can be used thereon and without modification thereof ;]

[said authorising program being for, when executed, authorising other software which being protected from unauthorised use, to be used on said computer (A) ;]

[wherein executable codes for performing an encryption algorithm used by a means for providing] **including** [identity] **information** [of] **specified to the rightful or authorised user of said authorising program**, [software, exists] **in said authorising program** [and] **in such a manner that said information** being accessible or, when said authorising program being executed, usable by a user ;

using said authorising software on a computer, for permitting use of said protected software on said computer ;

wherein said [identity] **information** being [for to be authenticated by a remote computer (B)] **essentially used, on said computer, in enabling of** [order for] **operation(s) for which said rightful or authorised user has to be responsible.** [to be performed by said remote computer (B) ;]

[wherein said computer comprises no hardware specific to said rightful or [authorised user for directly or indirectly authorising use of said other software] [thereon.]